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|-----------------|-------------|----------------------|---------------------|------------------|
| 09/697,364      | 10/26/2000  | Sally S. Botala      | BUR9-2000-0157-US1  | 3655             |

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EXAMINER

TORRES, JOSEPH D

ART UNIT PAPER NUMBER

2133

8

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/697,364

**Applicant(s)**

BOTALA ET AL.

**Examiner**

Joseph D. Torres

**Art Unit**

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☒ Claim(s) 19-21 and 25-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Double Patenting***

1. Claim 28 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 19. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Note: The limitations in claims 19 and 28 are substantially identical rearrangements of each other. In addition, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Hence, claims 19 and 28 are substantial duplicates of each other.

### ***Claim Objections***

2. Claims 19-21 and 25-28 are objected to because of the following informalities: Claim 19 recites, "the test program appearing to the ATE as a test for a single integrated circuit". The Examiner asserts that the phrase "the test program appearing to the ATE as a test for a single integrated circuit" fails to further limit the claim language

since “a test program appearing to the ATE as a test for a single integrated circuit” is purely subjective and provides no structural information about the test program to identify what makes it appear “to the ATE as a test for a single integrated circuit”. The Examiner assumes the other limitations in claim 19, not including the language “the test program appearing to the ATE as a test for a single integrated circuit”, define what it means for “the test program” to appear “to the ATE as a test for a single integrated circuit” and that any Prior art that satisfies the said other limitations inherently provides a “test program appearing to the ATE as a test for a single integrated circuit”.

Claims 25 and 28 recite similar language as in claim 19

Claims 20 and 21 depend from claim 19, hence inherit the limitations of claim 19.

Claims 26 and 27 depend from claim 25, hence inherit the limitations of claim 25.

**Note: as such claims 19-21 and 25-28 are substantially *identical* to previously examined claims 19-21 and 25-27.**

Appropriate correction is required.

Claim 28 is objected to because of the following informalities:

The limitations in claims 19 and 28 are substantially identical rearrangements of each other. In addition, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Hence, claims 19 and 28 are substantial duplicates of each other.

Appropriate correction is required.

### ***Response to Amendment***

3. Applicant's arguments filed 11 February 2004 have been fully considered but they are not persuasive.

The Applicant contends, "Turnquist fails to teach or suggest the creation of a test program that appears to the ATE as if it were written to test a single integrated circuit". The Examiner disagrees and asserts that appearing "to the ATE as if it were written to test a single integrated circuit" is purely subjective and defines no structure which would make a program appear "to the ATE as if it were written to test a single integrated circuit". As such, the other limitations in claim 19, not including the language "the test program appearing to the ATE as a test for a single integrated circuit", define what it means for "the test program" to appear "to the ATE as a test for a single integrated circuit" and any Prior art that satisfies the said other limitations inherently provides a "test program appearing to the ATE as a test for a single integrated circuit".

Since Turnquist is explicitly directed to a single ATE system, which behaves as a multiple logic tester and since Turnquist explicitly teaches all said other limitations in

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claim 19; Turnquist teaches "a test program appearing to the ATE as a test for a single integrated circuit".

The Examiner would like to point out that MPEP § 706.07 states that the claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. The Examiner asserts that claims 19-28 are the same invention as rejected in the previous Office Action and would have been properly finally rejected on the grounds and art of record in the next Office action, if they had been entered in the earlier application. Note: claim 28 is substantially identical to claim 19 and newly added language in amended claims 19 and 25 does not further limit the previously examined claim language of claims 19-27 as pointed out, above.

The Examiner disagrees with the applicant and maintains all rejections of claims 19-28. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 19-28 are not patentably distinct or non-obvious over the prior art of record in view of the reference, Turnquist, James Alan (US 6557128 B1) as applied in the last office action, Paper No. 5. Therefore, the rejection is maintained.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 19-28 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Turnquist, James Alan (US 6557128 B1).

35 U.S.C. 102(e) rejection of claim 19.

See Paper No. 5 for detailed action of prior rejections.

Note: The Examiner asserts that “the test program appearing to the ATE as a test for a single integrated circuit” fails to further limit the claim language since “a test program appearing to the ATE as a test for a single integrated circuit” is purely subjective and provides no structural information about the test program to identify what makes it appear “to the ATE as a test for a single integrated circuit”. The Examiner assumes the other limitations in claim 19, not including the language “the test program appearing to the ATE as a test for a single integrated circuit”, define what it means for “the test program” to appear “to the ATE as a test for a single integrated circuit” and that any Prior art that satisfies the said other limitations inherently provides a “test program appearing to the ATE as a test for a single integrated circuit”.

35 U.S.C. 102(e) rejection of claim 20.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 21.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 22.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 23.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 24.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 25.

See Paper No. 5 for detailed action of prior rejections.

Note: The Examiner asserts that "the test program appearing to the ATE as a test for a single integrated circuit" fails to further limit the claim language since "a test program appearing to the ATE as a test for a single integrated circuit" is purely subjective and provides no structural information about the test program to identify what makes it



appear "to the ATE as a test for a single integrated circuit". The Examiner assumes the other limitations in claim 19, not including the language "the test program appearing to the ATE as a test for a single integrated circuit", define what it means for "the test program" to appear "to the ATE as a test for a single integrated circuit" and that any Prior art that satisfies the said other limitations inherently provides a "test program appearing to the ATE as a test for a single integrated circuit".

35 U.S.C. 102(e) rejection of claim 26.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 27.

See Paper No. 5 for detailed action of prior rejections.

35 U.S.C. 102(e) rejection of claim 28.

See the rejection to claim 19 in Paper No. 5 for detailed action of prior rejections.

Note: The limitations in claims 19 and 28 are substantially identical rearrangements of each other. In addition, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,

152, 88 USPQ 478, 481 (CCPA 1951). Hence, claims 19 and 28 are substantial duplicates of each other.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

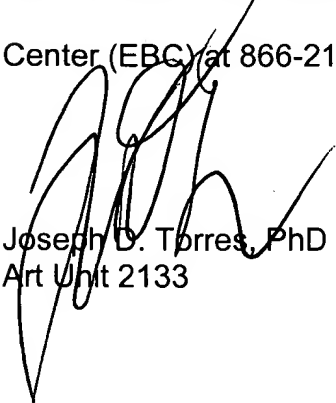
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (703) 308-7066. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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